



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,784	07/31/2001	Jeffry J. Grainger	020313-000510US	4833
20350	7590	07/07/2006	EXAMINER	
TOWNSEND AND TOWNSEND-AND CREW, LLP			MOONEYHAM, JANICE A	
TWO EMBARCADERO CENTER			ART UNIT	
EIGHTH FLOOR			PAPER NUMBER	
SAN FRANCISCO, CA 94111-3834			3629	

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/919,784	<b>Applicant(s)</b> GRAINGER ET AL.	
	<b>Examiner</b> Janice A. Mooneyham	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This is in response to the applicant's communication filed on March 31, 2006, wherein:

Claims 1-30 are currently pending;

Claims 1-5, 10-12, and 16-21 have been amended;

Claims 22-30 have been added.

### *Response to Amendment*

#### *Drawings*

a. The drawing objection has been withdrawn.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the applicant claims:

receiving, at a data processing system comprising a first database, a signal from a client system, the signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office, ***the reference information comprising a set of IDS information that can be used to create an IDS for disclosing the electronic document to an official patent office***

The highlighted portion describes the information. It is therefore not clear what the applicant is claiming in this step. It appears that all that is occurring is receiving a signal from a system at a first database.

The claim language goes on to read:

in response to the signal, accessing the electronic document at a second database external to the data processing system

This step is unclear. What is happening here? A signal is received in a first database. In response to the signal, an electronic document is accessed at a second database. Who or what is doing the accessing?

The next step is:

loading into the first database at least a portion of the electronic document, wherein the at least a portion of the electronic document comprises the IDS information; What does the applicant mean by "loading at least a portion of the electronic document"?

The next step is:

accessing an electronic IDS corresponding to a patent application; and adding the IDS information to the electronic IDS.

It appears that the applicant is essentially storing IDS information at a first database and then adding the information into an electronic IDS.

Claims 2 and 17 read:

wherein the electronic document includes a plurality of fields for storing the IDS information, and wherein adding the IDS information to the electronic IDS comprises

extracting the IDS information from each of the plurality of fields and storing the IDS information in a corresponding plurality of fields in the electronic IDS.

This language is unclear. What does the applicant mean by the language ***extracting the IDS information from each of the plurality of fields***. Is the applicant claiming prior art references with a plurality fields are does just the electronic IDS have a plurality of fields?

Claim 3 claims a reference link stored to the electronic document, storing a reference to each of one or more patent cases, and linking the references and the patent cases. Are the patent cases applications or are they prior art references?

Claim 4 claims adding the IDS information to the electronic IDS comprises storing the IDS information in the electronic IDS. Is the applicant referring to the reference number? What exactly is being stored in the electronic IDS?

Claim 16 claims:

storing in a reference table, a reference link to the electronic document;  
in a case table, linking a first case to the reference link; and  
adding the IDS information to an electronic IDS for the first case.

What does the applicant mean by the language "in a case table, linking a first case to the reference link? What does the applicant identify as a case table? Is this a pending application?

Claim 18 reads:

storing one or more cited reference links to a plurality of electronic documents in a cited reference table, ***the cited reference links indicating that the plurality of electronic documents that have cited to a patent office***

What does the applicant mean *by the link indicating that the plurality of electronic documents that have been cited to a patent office?*

The claim goes on to read:

wherein the IDS information is added to the electronic IDS only if the electronic IDS has a reference link in the reference table but does not have a cited reference link in the cited reference table.

This language is unclear to the Examiner.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 29-30 are directed to a system comprising computer readable instructions.

MPEP Section 2106 B (1) states:

#### **1. Nonstatutory Subject Matter**

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which

Art Unit: 3629

constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

**(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se**

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

NOTE: The Examiner finds that it is difficult to completely construe the claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections, the claims are construed and the art is applied as *much as practically possible*.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Porcari (US 2001/0037460) (hereinafter referred to as Porcari).

Referring to Claims 1 and 22-30:

Porcari discloses a computer implemented method, a program and a system for generating an information disclosure statement comprising:

a computer system with a database and a processor and a computer readable medium in communication with the processor which when executed by the computer performs the steps of (Figure 1 and paragraphs [0024-0032];

receiving, at a data processing system comprising a first database, a signal from a client system, the signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office, the reference information comprising a set of IDS information that can be used to create an IDS for disclosing the electronic document to an official patent office [0056-0058];



in response to the signal, accessing the electronic document at a second database external to the data processing system [0056-0057];

loading into the first database at least a portion of the electronic document, wherein the at least a portion of the electronic document comprises the IDS information; statement (IDS) information [0056-0057];

accessing an electronic IDS corresponding to a patent application [0056-0057] ;  
and

adding the IDS information to the electronic IDS [0056-0057].

Referring to Claim 16:

Porcari discloses a computer implemented method of generating an information disclosure statement comprising:

receiving, at a data processing system comprising a first database, a signal from a client system, the signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office, the reference information comprising a set of IDS information that can be used to create an IDS for disclosing the electronic document to an official patent office [0056-0058];

in response to the signal, accessing the electronic document at a second database external to the data processing system [0056-0057];

loading into the first database at least a portion of the electronic document, wherein the at least a portion of the electronic document comprises the IDS information; statement (IDS) information [0056-0057];

storing in a reference table a link to the electronic document and linking the electronic document with a case [0056-0057]; and

adding the IDS information to the electronic IDS [0056-0057].

Referring to Claims 2 and 17:

Porcari discloses wherein the electronic document includes plurality of fields for storing the IDS information, and wherein adding the IDS information to the electronic IDS comprises extracting the IDS information [0056-0058].

Referring to Claim 3:

Porcari discloses wherein associating the electronic document with one or more patent documents comprises:

storing a reference link to the electronic documents in a reference table [0056-0058];

storing the one or more patent cases in a case number table [0056-0058]; and

linking each of the one or more patent cases to the reference link in the reference table [0056-0058].

Referring to Claim 4:

Porcari discloses wherein associating the IDS information includes storing the IDS information in the electronic information disclosure statement [0056-0058].

Referring to Claim 5:

Porcari discloses extracting IDS information from the reference information [0045] and [0056-0058].

Referring to Claim 6:

Porcari discloses wherein the IDS information is extracted from the reference information automatically in response to the signal [0056-0058].

Referring to Claim 7:

Porcari discloses providing a create prompt to the user for generating the create signal [0039] and [0045].

Referring to Claim 8:

Porcari discloses wherein the create prompt comprises an electronic button (Figure 1(14)).

Referring to Claim 9:

Porcari discloses wherein the database is coupled to the remote server system over a computer network [0024-0026].

Referring to Claim 10:

Porcari discloses providing access to the electronic information disclosure statement to multiple users over a network [0025].

Referring to Claim 11:

Porcari discloses electronically transmitting the electronic information disclosure statement to a patent office [0009] and [0058].

Referring to Claim 12:

Porcari discloses receiving a signal indicating that an is being electronically filed in a patent office [0054-0055]; and

electronically transmitting the electronic information disclosure statement to the patent office [0009], [0045] and [0058].

Referring to Claims 13-15 and 19-21:

Porcari discloses wherein the electronic document is an electronic version of a United States Patent, a foreign patent document, or an electronic version of a publication [0056-0058].

Referring to Claim 18:

Porcari discloses storing one or more cited reference links to one or more of the electronic documents in a cited reference table, the cited reference links being associated with the electronic documents that have been cited to a patent office [0056-0058];

wherein associating the IDS information comprises associating the IDS information for each of the one or more electronic documents that have reference links in the reference table but do not have cited reference links in the cited reference table with an electronic invention disclosure statement for the case in response to the signal [0045] and [0056-0058].

***Response to Arguments***

5. Applicant's arguments filed March 31, 2006 have been fully considered but they are not persuasive.

The applicant argues that Porcari does not disclose receiving a signal indicating that a user has identified an electronic document containing reference information to be disclosed to a patent office. The Examiner respectfully disagrees. Porcari discloses allowing various documents to be selected as being on point [0045]. The Examiner interprets the selecting to be a signal that the user has identified a document containing reference information.

The applicant states that Porcari does not teach adding the IDS information to the electronic document. The Examiner disagrees. Porcari discloses linking the prior art to the IDS via hyperlinks. Thus, the hyperlink is IDS information added to the electronic IDS. Moreover, if applicant is adding the IDS document to the IDS form, the Examiner asserts there is a lack of enablement. It is not clear how you could add a document to the field lines of an electronic IDS.

Furthermore, the Examiner asserts that Porcari discloses the limitations of claim 16 as understood by the Examiner and directs the applicant to [0058].

As for applicant's argument as to claim 2, the Examiner is interpreting claim 2 as best the Examiner understands claim 2. As set forth above, it is not clear how one adds IDS information to the electronic IDS by extracting IDS information from a plurality of fields. If applicant is not disclosing storing a hyperlink to the prior art reference

Art Unit: 3629

document, the Examiner asserts that there is a lack of enablement as to how one adds a document to the line fields of an electronic IDS.

Referring to Claim 18, the Examiner is not clear what the applicant is claiming, as indicated by the 112, second paragraph rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

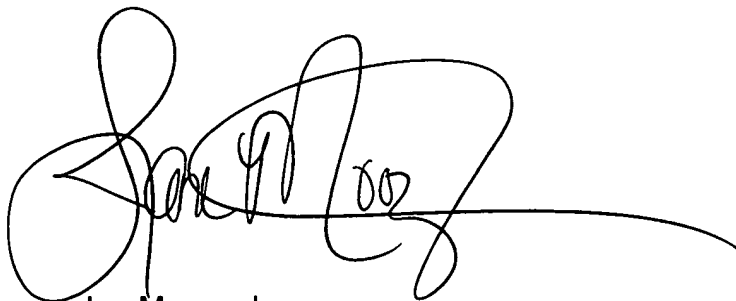
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a long horizontal line extending to the right.

Jan Mooneyham  
Patent Examiner  
Art Unit 3629